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10/801,875

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David Michael Suprock

KZG100US

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT

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3711

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/801,875	Applicant(s) SUPROCK ET AL.	
	Examiner Sebastiano Passaniti	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-38 and 49-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-38 and 49-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is responsive to communication received 02/17/2007 –
Amendment.

Claims 1-15, 17-38 and 49-58 remain pending.

The indicated allowability of the claims, as set forth on page 4 of the last Office action, mailed 09/18/2006, is withdrawn in view of the newly discovered reference(s) to Long (U.S. Patent 7,192,364). Rejections based on the newly cited reference(s) follow.

At the outset, it is noted that the instant application claims priority to a provisional application serial no. 60/454,566, filed March 17, 2003. A review of this '566 provisional application indicates that the claimed subject matter of the instant application is not fully supported by the disclosure (specification and drawings) of the provisional application. Thus, the earliest effective filing date upon which the applicant may rely for support of the claimed subject matter is the actual filing date of this pending application; that is, March 16, 2004.

On the other hand, it is noted that the Long patent, issued March 20, 2007 and used in the following rejections, includes an earliest effective filing date of May 27, 2003, based upon a provisional application serial no. 60/473,305. This '305 provisional application fully supports all of the features disclosed and claimed in the '364 Long patent. Thus, Long clearly qualifies as prior art under 35 USC §102(e), as the earliest effective filing date of the Long patent antedates the actual filing date of the current application under examination.

Following is an action on the MERITS:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15, 17, 18, 20-37 and 49-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Long (U.S. Patent 7,192,364). Note, the following rejection will often refer to the phrase “secondary plate”, as used by Long, interchangeably with the phrase “back face”, as required in the applicant’s claims. The secondary plate of Long is deemed to structurally serve as the back face required by the applicant.

As to claim 1, note front face (16) that is attachable to a golf club head body and having a front face center, i.e., the geometric center of the face. Note the back face (28) shown in Figure 7, for example, and welded around its periphery (as shown by weld 34). See column 3, lines 60-63, wherein Long details that the secondary plate (28) is welded around its entire periphery. Long notes that the secondary plate (28) may be fabricated of the same material as the face plate (16). See column 3, lines 55-58. Thus, this secondary plate of back face has a tensile strength at least equal to the tensile strength of the front face and a plasticity at least equal to the plasticity of the front face.

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As to claim 2, Long details that the secondary plate (28) limits the amount of deflection of the front face and thus limits the trampoline effect by increasing the rigidity of the front face. The deflection of the front face is altered in other than just the sweet spot as evidenced by the fact that diverse configurations and sizes are available for the secondary plate. See column 3, lines 26-54 and column 4, lines 1-13.

As to claim 3, note that the raised ring or thickened edge (242) may be discontinuous around the periphery of the secondary plate. As shown in Figure 12, the raised edge (242) may, when formed in a discontinuous manner, would include a plurality of raised ridges extending away from the front face.

As to claim 4, the secondary face in Long can be approximately $1/4$ to $1/3$ of the surface area of the front face (column 4, line 7-12).

As to claim 5, the secondary plate, in one embodiment, is attached to the front face only along a periphery of the back face (column 3, lines 60-63).

As to claims 6 and 7, in addition to what has already been discussed for claim 1, supra, note that the back face is separated from the front face by about 0.010 to 0.115 inch (0.254 to 2.921 mm). See column 4, lines 13-18.

As to claim 8, since the back face may be attached around its entire periphery to the front face, a hollow space exists between the front and back faces. This space is at least filled with air. It is noted that air, even at ambient pressure, is indeed a gas.

As to claims 9, 10 and 11, the front face includes a thickness of 0.085 to 0.120 inch (2.159 to 3.048 mm). See column 3, lines 13-14). The secondary plate (28) can have a thickness of about 0.020 to 0.062 inch (0.508 to 1.575 mm). Thus, the front face

thickness is greater than the back face thickness. The more specific claimed dimensions of claims 10 and 9 clearly fall within the range of dimensions disclosed by Long.

As to claim 12, the secondary plate (28) may be circular (column 3, lines 36-37).

As to claim 13, the secondary plate may be shaped as a polygon (column 4, lines 33-36).

As to claim 14, the secondary plate may be elliptical in shape (column 3, lines 43-46).

As to claim 15, the secondary plate may be square-shaped (column 3, lines 51-54).

As to claims 17 and 18, the back face in Long may take up an area as small as about $1/4$ to $1/3$ (25% to 33%) of the surface area of the front face to focus the effect of the secondary plate on the sweet spot of the face. Alternatively, the back face or secondary plate in Long may take up as much as the entire surface area of the front face, since Long suggests that the periphery of the back face may extend to at least one of the crown, sole, toe heel. Thus, it is clear that the back face may take up as much as 90% of the area of the front face.

As to claim 20, the comments for claim 1 are incorporated herein by reference. Moreover, Figure 8 shows that at least a sole portion of the club head body includes an inwardly extending front peripheral surface, wherein the laminated face that consists of a front face and a back face secured thereto attaches to the peripheral opening of the club head body to help form a hollow interior.

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As to claim 21, Long details that the secondary plate (28) limits the amount of deflection of the front face and thus limits the trampoline effect by increasing the rigidity of the front face. The deflection of the front face is altered in other than just the sweet spot as evidenced by the fact that diverse configurations and sizes are available for the secondary plate. See column 3, lines 26-54 and column 4, lines 1-13.

As to claim 22, note that the raised ring or thickened edge (242) may be discontinuous around the periphery of the secondary plate. As shown in Figure 12, the raised edge (242) may, when formed in a discontinuous manner, would include a plurality of raised ridges extending away from the front face.

As to claim 23, the secondary face in Long can be approximately $\frac{1}{4}$ to $\frac{1}{3}$ of the surface area of the front face (column 4, line 7-12).

As to claim 24, the secondary plate, in one embodiment, is attached to the front face only along a periphery of the back face (column 3, lines 60-63).

As to claims 25 and 26, in addition to what has already been discussed for claim 1, supra, note that the back face is separated from the front face by about 0.010 to 0.115 inch (0.254 to 2.921 mm). See column 4, lines 13-18.

As to claim 27, since the back face may be attached around its entire periphery to the front face, a hollow space exists between the front and back faces. This space is at least filled with air. It is noted that air, even at ambient pressure, is indeed a gas.

As to claims 28, 29 and 30, the front face includes a thickness of 0.085 to 0.120 inch (2.159 to 3.048 mm). See column 3, lines 13-14). The secondary plate (28) can have a thickness of about 0.020 to 0.062 inch (0.508 to 1.575 mm). Thus, the front face

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thickness is greater than the back face thickness. The more specific claimed dimensions of claims 10 and 9 clearly fall within the range of dimensions disclosed by Long.

As to claim 31, the secondary plate (28) may be circular (column 3, lines 36-37).

As to claim 32, the secondary plate may be shaped as a polygon (column 4, lines 33-36).

As to claim 33, the secondary plate may be elliptical in shape (column 3, lines 43-46).

As to claim 34, the secondary plate may be square-shaped (column 3, lines 51-54).

As to claim 35, in addition to the comments for claim 1, *supra*, note that the Long patent details that the laminated face is attached to a club head body having a crown, sole and side portions (Figure 1).

As to claims 36 and 37, the back face in Long may take up an area as small as about $1/4$ to $1/3$ (25% to 33%) of the surface area of the front face to focus the effect of the secondary plate on the sweet spot of the face. Alternatively, the back face or secondary plate in Long may take up as much as the entire surface area of the front face, since Long suggests that the periphery of the back face may extend to at least one of the crown, sole, toe heel. Thus, it is clear that the back face may take up as much as 90% of the area of the front face.

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As to claims 49 and 50, in addition to the comments for claims 1 and 2, supra, note that the Long patent details that the laminated face is attached to a club head body having a crown, sole and side portions (Figure 1).

As to claim 51, note that the raised ring or thickened edge (242) may be discontinuous around the periphery of the secondary plate. As shown in Figure 12, the raised edge (242) may, when formed in a discontinuous manner, would include a plurality of raised ridges extending away from the front face.

As to claim 52, the secondary face in Long can be approximately 1/4 to 1/3 of the surface area of the front face (column 4, line 7-12).

As to claim 53, the secondary plate, in one embodiment, is attached to the front face only along a periphery of the back face (column 3, lines 60-63).

As to claims 54 and 55, in addition to what has already been discussed for claim 1, supra, note that the back face is separated from the front face by about 0.010 to 0.115 inch (0.254 to 2.921 mm). See column 4, lines 13-18.

As to claim 56, since the back face may be attached around its entire periphery to the front face, a hollow space exists between the front and back faces. This space is at least filled with air. It is noted that air, even at ambient pressure, is indeed a gas.

As to claims 57 and 58, the front face includes a thickness of 0.085 to 0.120 inch (2.159 to 3.048 mm). See column 3, lines 13-14). The secondary plate (28) can have a thickness of about 0.020 to 0.062 inch (0.508 to 1.575 mm). Thus, the front face thickness is greater than the back face thickness. The more specific claimed

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dimensions of claims 10 and 9 clearly fall within the range of dimensions disclosed by Long.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long (U.S. Patent 7,192,364). Although Long does not show another back face secured to the secondary plate (28), it is clear that attaching another back face to the secondary plate would simply have amplified the effect of the secondary plate. This would have been a matter of common sense. Thus, the skilled artisan, seeking to further control the trampoline effect of the front face during ball impact, would have found it obvious to modify the Long device by including another back face to the secondary plate.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification lacks proper antecedent basis for the "another back face" recited in original claims 19 and 38.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "another back face" (claims 19 and 38) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Further References of Interest

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note Figures 3 and 5 in Shieh.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection, supra. Any inconvenience to the applicant is sincerely regretted.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.Passaniti/sp
May 25, 2007


Sebastiano Passaniti
Primary Examiner